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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,636	12/23/2000	Dann E. Kroeger	ATUBP005	1546
7590	08/20/2004		EXAMINER	
Robert J. Rayburn, Esq. Holman, McCollum & Hansen 10740 Nall Avenue Suite 200 Overland Park, KS 66211			BLACKWELL, JAMES H	
			ART UNIT	PAPER NUMBER
			2176	
			DATE MAILED: 08/20/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/745,636	KROEGER, DANN E.	
	Examiner	Art Unit	
	James H Blackwell	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 December 2000.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 December 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

Independent Claims 1 and 9, and dependent Claims 2-8 are rejected under 35 U.S.C. 101 because they are not in the technological arts as the claims are so broad as to encompass a pen and paper and a user accomplishing the claim.

Independent Claim 10, and dependent Claims 11-15, and 18 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter. Independent Claim 10 is a computer program per se, and is not tangibly embodied on a computer readable medium. Claims 11-15, and 18 are also non statutory as they fail to correct the problem with Claim 10.

Independent Claim 19 is rejected under 35 U.S.C. 101 because it is directed to non-statutory subject matter. Independent Claim 19 is directed towards logic elements that are software subroutines per se, and are not tangibly embodied on a computer readable medium.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 7-13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail (U.S. Patent No. 5,063,495).

In regard to independent Claim 1 (and similarly independent Claims 10, and 19), MacPhail teaches in Fig. 1 a document management system (10) that controls the creation, retrieval, editing and distribution of documents within an information processing system (not shown). Documents that are created by an end user (EU) are stored in a library (12). The library (12) performs various services for the system (10). These services are used for storing and retrieving documents electronically. The library (12) also provides the following services: deleting documents from the library; updating work in progress documents in the library; specifying a security level to be associated with the document which is being filed; allowing authorized end users other than the author/owner to retrieve a document from the library; and performing searches for and retrieving documents filed in the library for other end users (Col. 2, lines 35-57; compare with Claim 1 (and similarly Claims 10, and 19), “... **(a) maintaining a database of documents**”). MacPhail does not specifically teach a “database”.

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However, MacPhail does teach a “library”, which contains many of the features of a “database” (see above). Therefore, one of ordinary skill in the art at the time of invention would have concluded that a “library”, as taught by MacPhail, is functionally equivalent to the broad notion of a “database”, providing the benefit of storing, maintaining, extracting and searching documents. MacPhail also teaches a method of marking a document for review and specifying status and notification criteria whereby an automatic response is generated upon the updating of the status to match the notification criteria. A requesting EU marks a section of a document to be reviewed by a responding EU. The action to be performed by the responding EU, an identification of the responding EU and a due date (here, the responding end user (EU) will see the due date when he looks at the document) (Col. 1, lines 45-58; compare with Claim 1 (and similarly Claims 10, and 19), “**... (b) determining a due date associated with the documents**”). MacPhail also teaches that after the document has been marked, the document is filed and the responding EU or EUs may be given access to the document to complete the review thereof. Alternately, the document can be transmitted to the responding EU or EUs for review. When the responding EU or EUs have complete their respective review of the document, the status associated with the action is updated. If the updated status is the same as the notification criteria (compare with Claim 1 (and similarly Claims 10, and 19), “**... (c) monitoring a status of the documents**”) (Col. 1, lines 59-65) a message is automatically transmitted to the end user associated with the notify ID (Col. 1, lines 66-67; compare with Claim 1 (and similarly Claims 10, and 19), “**... (d) generating alerts based on the due date and status of the documents**”).

In regard to dependent Claim 2 (and similarly dependent Claim 11), MacPhail does not specifically teach that *the documents are selected from the group consisting of: site evaluations & assessments, drawings, specifications, addenda, purchase orders, contracts, inspections, tests, and material inventory*. However, MacPhail does teach manipulating business documents (Col. 1, lines 26-42) making it obvious to one of ordinary skill in the art at the time of invention to realize that the act of manipulating business documents would have likely included one or more of the claimed documents as well as others not specifically mentioned, providing the benefit of tracking the progress of a business document through a review process.

In regard to dependent Claims 3-4 (and similarly dependent Claim 12-13), MacPhail teaches that after the document has been marked (status), the document is filed (submitted to database) and the responding EU or EUs may be given access to the document to complete the review thereof. Alternately, the document can be transmitted to the responding EU or EUs for review (retrieving documents). When the responding EU or EUs have complete their respective review of the document, the status associated with the action is updated (Col. 1, lines 59-66; compare with Claim 3 (and similarly Claim 12), “**... the status indicates that the documents are submitted to the database**”) and Claim 4 (and similarly Claim 13), “**... the status indicates that the documents are retrieved**”).

In regard to dependent Claim 7 (and similarly dependent Claim 16), MacPhail teaches that a message is automatically transmitted to the end user associated with the

notify ID (Col. 1, lines 66-67; compare with Claim 1 (and similarly Claims 10, and 19),
“... the alerts include electronic message notifications”.

In regard to dependent Claim 8 (and similarly dependent Claim 17), MacPhail teaches that a requesting EU marks a section of a document to be reviewed by a responding EU. The action to be performed by the responding EU, an identification of the responding EU (ID is user-defined) and a due date, which are specified by the requesting EU, becomes a part of the document and are associated with a begin action marker and an end action marker (Col. 1, lines 49-55; compare with Claim 8 (and similarly Claim 17), **“... a destination of the electronic message notification is user-defined for each document”**).

In regard to dependent Claim 9 (and similarly dependent Claim 18), MacPhail teaches that when the responding EU or EUs have completed their respective review of the document, the status associated with the action is updated. If the updated status is the same as the notification criteria a message is automatically transmitted to the end user associated with the notify ID (Col. 1, lines 63-67; compare with Claim 9 (and similarly Claims 18), **“... the alerts are generated upon completion of the documents being overdue”**).

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail in view of Shrader et al. (hereinafter Shrader, U.S. Patent No. 5,900,874).

In regard to dependent Claim 5 (and similarly dependent Claim 14), MacPhail teaches that the EU may retrieve documents, which were previously stored in the library

(12), for editing and/or distribution by interacting with a text editor (14) (Col. 2, lines 58-60). MacPhail also teaches that the text editor (14) supports the Revisable Form Text format (RFT) (Col. 2, line 67; Col. 3, lines 1-4). MacPhail does not specify what RFT is. However, Shrader teaches that RFT is used to convert from one document type to another (Col. 2, lines 49-51; compare with Claim 5 (and similarly Claim 14), “***... the documents have a plurality of different formats, and a universal browser is used to view the documents***”). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of MacPhail and Shrader because both deal with importing documents to an editor, which were previously in different formats. The benefit would have been a editor (editors can be used to browse a document) to allow one to view a variety of document formats.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacPhail in view of Nakao (U.S. Patent No. 6,061,697).

In regard to dependent Claim 6 (and similarly dependent Claim 15), MacPhail fails to teach a *log is created indicating a person and a time associated with edits to the documents*. However, Nakao teaches history information composed of two kinds of information: one managed for each document and one managed for each document element. The history information managed for each document includes system assigned information and user assigned information. Examples of the system assigned information are a revision date and time (time associated with edits), a reviser (person associated with edits), and a revised portion. Examples of the user assigned information

are a revision name and a comment. The history information managed for each document is assigned a unique revision number in the order of all revisions through the life cycle of the document. The history information managed for each document is master data (Col. 20, lines 48-60). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of MacPhail and Nakao because both deal with managing a plurality of documents. Adding the teachings of Nakao provide the benefit of tracking the progress of a document.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
08/18/04



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER